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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,076	10/30/2003	Robert T. Clark	33737/US	8144
7590 Devan V. Padmanabhan DORSEY & WHITNEY LLP Intellectual Property Department 50 South Sixth Street, Suite 1500 Minneapolis, MN 55402-1498		05/02/2008		
EXAMINER PLUCINSKI, JAMISUE A				
ART UNIT 3629		PAPER NUMBER		
MAIL DATE 05/02/2008		DELIVERY MODE PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/697,076

Applicant(s)

CLARK ET AL.

Examiner

JAMISUE A. PLUCINSKI

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/55/08)
Paper No(s)/Mail Date 20050114
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____

DETAILED ACTION

Claim Objections

1. Claims 1-3, 6-10 and 26-28 are objected to because of the following informalities: These claims are objected to for failing to complete the objective which is set forth in the preamble. In Claims 1-3 and 6-10, the preamble of the claims state a method for assessing the risk of fraud, however the steps performed in the claims are simply measuring the different in demographic information between addresses, they do not assess the risk of fraud. In Claims 26-28, the preamble states determining if an account request involves fraud, however the steps merely calculate a score which indicates whether the request "may" involve fraud, there is no step of positively determining if fraud exists. Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-33 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The claims are directed to a method of assessing the risk of fraud using demographic information, and calculating a score that is indicative of whether there may be fraud. In the specification, the applicant gives variables which are used, to measure the difference in demographic information between two addresses,

however it is unclear from the specification how these variables and the weights that are given are obtained to used to determine the score. On Page 21, the applicant states how DF_INCOME is obtained, and also describes how DF_NETWR is calculated. In page 22, the applicant states that the $DF_HOMEON = HOMEON(FROM) - HOMEON(TO)$, which is a difference between the value of the percentage of home ownership. These can be fairly high numbers, then further outlines how to get VALUE1, then further states how some values can be either a 1 or a 0. These values are plugged into an equation on Page 27 and somehow coefficients are determined for some of these values. However, the equation uses a variable A, which is a constant value, and the applicant never defines this constant, can it be chosen at random? It is also unclear how the coefficients are exactly determined, it states a statistical regression analysis, but on what set of data? Do these coefficients remain the same with every calculation? If another variable is added into the equation, will all the coefficients change, and how so? How is the data collected to come up with these coefficients. The specification states that more or less variables can be used (the claims specifically state at least one, which means only one variable can be used in this equation), therefore if more or less is used, then the entire equation will change and the specification does not describe how these coefficients are obtained for one of skill in the art to determine how to obtain them to obtain the score, which is used to assess the risk of fraud.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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5. Claims 1-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
6. With respect to Claim 1: the method receives information relating to a first address and a second address, and then measures demographic differences between the first and second address, however the claims never state that the “demographic” data is obtained, therefore it is unclear how the differences can be measured if the information is never obtained.
7. Claims 5, 8 9, 15, 17, 18, 21, 32 and 33 recite the limitation “the act” in line 1. There is insufficient antecedent basis for this limitation in the claim.
8. With respect to Claim 6: the phrase “using demographic data relating to the address information” is indefinite. Demographic data was never collected or received, therefore it is unclear how it can be used. Furthermore, it is unclear how the information is used, and what it is used for.
9. With respect to Claim 10: the phrase “measuring at least one difference in demographic data appended to the first and reference address information” is indefinite. Again, the claims never positively state collecting demographic data, nor do they state “appending” them to the address information, therefore it is unclear how the difference can be measured if the information was not positively obtained in the claims.
10. With respect to Claim 13: the phrase “analyzing negative data” is indefinite. It is unclear to the examiner where the negative data is coming from, and what exactly it is.

11. With respect to Claim 15: the claim analyzes differences between demographic attributes to predict the risk of fraud, however it is unclear as to what kind of fraud, and how the address relate to fraud.
12. Claim 16 recites the limitation "the assessment of fraud" in line 1. There is insufficient antecedent basis for this limitation in the claim.
13. With respect to Claim 22: the phrase "coupling negative and positive information with address demographic attributes to assess the risk of identity theft fraud" is indefinite. It is unclear where and how the negative and positive information is obtained. Is this obtained from some calculation, or from some database?
14. With respect to Claim 23: the phrases "USPS" and "NCOA" are indefinite. Even though acronyms might have common meanings, certain acronyms can stand for a multitude of different things. Therefore, the acronym must be accompanied by its written full term or phrase wherever it first appears in each independent claim.
15. With respect to Claim 23: the phrase "coupling differential information relating to the addresses to predict a risk of fraud" is indefinite. It is unclear to the examiner how the information is coupled, and information is exactly coupled, and how this is used to predict fraud. Does it take every known address which is combined in the first step and predict fraud for every occasion? It is also unclear what "the addresses" is referring to.
16. With respect to Claim 31: the phrase "providing a score and a reason" is indefinite. It is unclear to the examiner what the "reason" is. Is it the reason for the score? Or the reason for providing the assessment?

17. It should be noted that due to the claim objections as well as the amount of 112 rejections, a lack of prior art does not indicate that the claims are allowable. A claim must be written as a whole. If something is used in the calculation, then it must be positively recited as being collected, received or obtained first, within the body of the claim, the claims must stand on their own.

Conclusion

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Geschwender et al. (7,337,119) discloses the use of determining purchasing card fraud, in account take over, and discloses account take over modeling and scoring, Degen et al. (6,418,436) discloses the use of a scoring system for credit card fraud, Lee et al. (US 2002/0099649) discloses the use of a method for detecting fraudulent credit card purchases, Bosch et al. (US 2003/0225692) discloses the Use of an account opening system which matches addresses, Belsie, (The Orgonian article- Latest Scam Threatens Credit-Cart User Security) discloses that account takeovers are increasing and PR Newswire (Article February 22, 1999) discloses a company which is using fraud models for account takeover.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMISUE A. PLUCINSKI whose telephone number is (571)272-6811. The examiner can normally be reached on M-Th (5:30 - 4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jamisue A. Plucinski/
Primary Examiner, Art Unit 3629